

REMARKS

Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the telephonic interview held on July 12, 2006. During the telephonic interview, the Examiner and Applicants' attorney discussed possible claim amendments in order to emphasize differences between a food wrap and the diaper disclosed in Takahashi and the thermoplastic starch compositions of Andersen. Applicants' attorney also discussed the possibility that the invention date of at least some of the claims predates the issue date of Andersen, thereby making Andersen a reference under 35 U.S.C. § 102(e) rather than 102(a). If so, Andersen would not be citable to establish obviousness according to 35 U.S.C. § 103(c) since Andersen and the present application are, and have always been, commonly owned. Reconsideration and allowance of the above-identified application are therefore respectfully requested based on the foregoing amendments and the subsequent remarks.

Claims 1-35 and 39-41 remain pending in the application, wherein claims 1, 16, 18 and 32 have been amended in order to specifically claim an article of manufacture that is adapted for use as a food wrap. Claims 1, 16, 18 and 32 further state that the claimed sheet or film is thin and flexible so as to be easily wrapped around a food item and possesses sufficient dead-fold that it will remain wrapped around the food item absent application of an external force. A discussion of the nature and desirability of dead-fold when making a food wrap is found in the application at page 43, lines 9-15. A discussion of the desirability of providing thin sheets or films when making a wrap is found at page 45, lines 1-3 of the application (*i.e.*, teaching a thickness of less than about 250 microns, which is "thin"). A discussion of the desirability of providing flexible sheets or films when making a wrap is found at page 4, lines 3-5.

In addition, the claims state that the sheet or film, prior to being used to wrap a food item, includes a first exposed surface that contacts the food item when wrapped around the food item and a second exposed surface on a side of the sheet or film opposite the first exposed surface. This is an inherent property of food wraps made from sheets or films (*e.g.*, wraps used to package fast food, such as a burrito or taco).

As discussed during the telephonic interview, Takahashi et al. (US 5,374,259) discloses a disposable diaper that includes three distinct layers: (i) a liquid permeable layer that lies adjacent to the user's body; (ii) a liquid absorbing layer that lies adjacent to the liquid permeable layer; and (iii) a liquid resistant barrier layer that surrounds the liquid absorbing layer on a side

opposite the liquid permeable layer. All three layers are necessary in order to provide the desired moisture absorbing and retention properties of a diaper. Takahashi et al. neither teaches nor suggests separating one of the layers to make a food wrap, let alone having the properties recited in the claims as now presented. Nor would it have been obvious to modify Takahashi et al. to obtain the claimed food wraps of claims 1, 16, 18 and 32 since this modification would render Takahashi et al. unsuitable for its intended purpose and/or change its principle of operation. *See* MPEP § 2143.01. Applicants also note that Takahashi et al. fails to teach or suggest using a knurling or embossing-type roller to yield textured sheets or films as recited in claim 16. Nor does Takahashi et al. teach or suggest the desirability of providing sheets or films having the desired dead-fold properties while also being thin and flexible. Accordingly, Applicants submit that claims 1, 16, 18 and 32 as amended are neither anticipated by, nor obvious over, Takahashi et al., either alone or in combination with any other art of record. Neither are the claims that depend from claims 1, 16, 18 and 32. Claims 39-41 were not rejected over Takahashi et al. or any combination thereof.

Claims 1, 16, 18 and 32 also distinguish over Andersen et al., which discloses a wide range (*i.e.*, genus) of thermoplastic starch compositions and blends but does not identify dead-fold as a desired property or how to modify the compositions to inherently (*i.e.*, necessarily) obtain food wraps having the claimed level of dead-fold, while also being thin and flexible as recited in claims 1, 16, 18 and 32. The present application discusses in great detail the various properties of both soft and stiff biodegradable polymers and various ways to obtain sheets and films that have the required level of dead-fold, which is not automatically present in sheets that are also thin and flexible. Andersen et al., on the other hand, is primarily interested in providing thermoplastic starch and/or destructureized starch blends. Andersen et al. neither describes the desirability of providing thin, flexible sheets or films having the claimed level of dead-fold as recited in claims 1, 16, 18 and 32, nor does Andersen et al. describe how to specifically obtain thin, flexible sheets or films that possess this property. That sheets or films falling within the broad generic claims of Andersen et al. might in some cases, by sheer happenstance, have the required level of dead-fold is irrelevant. Disclosing a broad genus does not necessarily describe any particular species. Given the tremendous breadth of Andersen et al. on the one hand, coupled with the specificity required to obtain sheets and films that are both thin and flexible and that have the required dead-fold, it cannot reasonably be said that Andersen et al. inherently

discloses the claimed sheets and films of claims 1, 16, 18 and 32. The MPEP clearly requires a showing that a claimed property is necessarily present in the art to establish inherency, not that the property is possibly present, or even probably present. MPEP § 2112. In view of the foregoing, Applicants submit that claims 1, 16, 18 and 32 as amended are neither anticipated by, nor obvious over, Andersen et al.

Moreover, Andersen et al. fails to teach or suggest the composition of claim 39, which is a thermoplastic blend that includes starch that is free of plasticizers and that retains a substantial portion of its crystallinity. As discussed in the telephonic interview, Andersen et al. discloses two distinct methods of forming a thermoplastic starch material: (1) using a low boiling liquid plasticizer such as glycerin while reducing the water content to below 5% to form thermoplastic starch or (2) forming destructure starch by maintaining the water content between 5-40% throughout the entire process. Col. 20, ll. 41-46; col. 21, ll. 25-39. Because method (1) of Andersen et al. requires a low boiling liquid plasticizer, it contradicts the requirement in claim 39 that the thermoplastic starch "is free of plasticizers". Method (2), on the other hand, requires the water content to remain above 5% by weight in order to yield "destructure starch" which, by definition, lacks crystallinity, at least when initially formed, by virtue of including sufficient water to "destructure" the starch molecules. Col. 22, ll. 10-14 ("When destructure starch melts are initially formed, the water is able to interact with the hydroxyl groups of the starch molecules in order to interrupt the starch molecules and keep them from associating themselves into a more crystalline geometry"). Accordingly, Applicants submit that claim 39 is patentable over Andersen et al., either alone or in combination with any other art of record.

Applicants also point out that the declaration of Simon Hodson, submitted previously and effective in removing previously cited art as references, also establishes that at least some of the claims may enjoy an invention date that precedes the issue date of Andersen et al. That means that Andersen et al. is only prior art, if at all, under 102(e) rather than 102(a) for such claims. In such cases, Andersen et al. may only be used to anticipate such claims but cannot be used to establish obviousness, since, as now formally averred by the undersigned attorney, Andersen et al. and the present application are, and always have been, commonly owned.

In addition to the Hodson declaration, Applicants point to the disclosure of U.S. Patent No. 6,573,340 to Khemani et al., which constitutes a constructive reduction to practice of all that it describes. MPEP § 2138.05. Because the present application and Khemani et al. have the

same inventive entity, Khemani et al. can be used to establish an earlier invention date of all that it discloses as of its filing date, which is August 23, 2000, which predates the issue date of Andersen et al. For example, Khemani et al. extensively discusses the importance of dead-fold in the case of food wraps, as in claims 1, 16, 18 and 32. Khemani et al. also discloses texturing to increase dead-fold, as in claim 16. While Khemani et al. does not explicitly disclose specific percentages of dead-fold, Khemani et al. discloses many of the same compositions in its examples that are disclosed in the present application, thereby inherently disclosing the same levels of dead-fold as are disclosed in the present application.

In short, Applicants believe the claims as now amended are patentable over Andersen et al. Nevertheless, Applicants reserve the right to remove Andersen et al. as a reference under 102(a) in relation to at least some of the claims in order to prevent Andersen et al. from being used to establish the obviousness of such claims.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 13th day of July 2006.

Respectfully submitted,



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